

REMARKS

Claim 15 has been amended based on, e.g., the disclosure in the Examples, including Example 5.

Entry of the above amendment is respectfully requested.

Interview with Examiner

Applicants thank the Examiner for the telephone interview conducted with Applicants' representative on August 25, 2010. Applicants believe that it was helpful in advancing the prosecution of this application. A Statement of Substance of Interview is being submitted concurrently herewith.

Obviousness Rejection

On page 2 of the Office Action, claims 15, 18-19, 21, and 26-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al. in view of Takata et al. (J. Pharm. Sci., 1995, 84(1), pages 96-100) and Yasuaki. Also, on page 3 of the Office Action, claims 15, 18-19, 21, and 26-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke et al. in view of Takata et al. (J. Pharm. Sci., 1995, 84(1), pages 96-100).

The Examiner's Position

The Examiner's position in the Office Action appears to be based on a series of UV-exposures, such that when a tocopherol-containing composition is applied before a second or later UV-exposure, it is necessarily applied after the previous UV-exposure in the series of UV-exposures. Thus, the Examiner indicates that the mice in Burke have the tocopherol applied before the initial UV-exposure, and then again after that exposure (and before the next in the series of multiple UV-exposures). The Examiner considers that the experiment shows that

pigmentation is reduced when using tocopherol, and the tocopherol is applied (except for the initial application) after the subject was exposed to UV radiation. Thus, the Examiner considers that one of ordinary skill in the art would expect that by using tocopherols before being exposed (again) to UV-radiation, pigmentation could be reduced.

Applicants' Response

Applicants respectfully submit that the invention as recited in the amended claims is not obvious over the cited art combinations, and request that the Examiner reconsider and withdraw these rejections in view of the following remarks.

In particular, based on the amendment set forth above, Applicants submit that the rejection is inappropriate, particularly in view of the *Jansen* case cited in MPEP 2111.02 II.

That is, Applicants submit that the relevant case law includes *Jansen v. Rexall Sundown, Inc.*, 342.F.3d 1329, 1333-34, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003), wherein in a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," the court held that the preamble is not merely a statement of effect that may or may not be desired or appreciated, but rather is a statement of the intentional purpose for which the method must be performed. See MPEP 2111.02 II.

Thus, Applicants submit that the present claims should be properly interpreted to mean that the recited compound must be administered to a subject for the intentional purpose of reducing pigmentation of the skin after UV exposure.

Further, Applicants submit that the cited art does not disclose or suggest administering the recited compound to a subject *for the intentional purpose* of reducing pigmentation of the skin after UV exposure.

In this regard, Applicants note that Example 5 of the present application describes that the subject guinea pigs were exposed to UV rays and the effects of the lotions on the guinea pigs (subjects in need of reduction of pigmentation) were evaluated from 4 days after the exposure to 28 days. Therefore, the disclosure teaches that it is the spirit of the present invention to apply an effective amount of the cosmetic composition to a subject in need of reduction of pigmentation after a UV-exposure.

Thus, Applicants submit that the present invention is not obvious over the cited art combinations, and withdrawal of these rejections is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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